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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,494	03/18/2005	Enrico Maim	15675P538	8268

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EXAMINER

LE, MICHAEL

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/501,494	MAIM, ENRICO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Le	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 and 31-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Summary and Status of Claims***

1. This Office Action is in response to Application No. 10/501,494 filed July 12, 2004.
2. Claims 1-27 and 37-52 are withdrawn from consideration as being directed towards a non-elected invention.
3. Claims 28-36 are pending.
4. Claims 31-36 are objected to for improper form of multiple dependencies and are withdrawn from consideration.
5. Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph.
6. Claims 28-30 are rejected under 35 U.S.C. 101.
7. Claims 28-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chen et al. (US Patent Pub 2003/0005002) using the provisional application filing date.

### ***Specification***

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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9. The abstract of the disclosure is objected to because it recites implicating phrases such as "Disclosed is a method..." in line 1. It also recites legal phraseology and seems to be nothing more than a recitation of claim language. Correction is required. See MPEP § 608.01(b).

10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

11. **Claims 31-38** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 31-38 not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Regarding **claim 28**, the phrase "such as" in line 1 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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15. Also in **claim 28**, the acronym “URI” recited in line 3 is not defined by the language of the claim and it is unclear what applicant intends by reciting it. Furthermore, the intention of reciting “current page” in line 7 within parentheses is unclear.

16. Additionally, **claim 28** attempts to claim both a product in the form of a computer system and a process, which causes the claim to be indefinite. See MPEP 2173.05(p)(II).

17. **Claims 28-30** fail to recite active method steps. Failure to recite active, positive method steps when claiming a process raises the issue of indefiniteness. See MPEP 2173.05(q).

18. The prior art rejections below for claims 28-30 are made as best understood in light of the 35 U.S.C. 112, second paragraph rejections addressed above.

***Claim Rejections - 35 USC § 101***

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. **Claims 28-30 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

21. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

22. In the present case, **claims 28-30** attempt to claim both a product, in the form of a computer system, and a process. Since both are claimed, there is an overlap of two statutory categories of invention. Accordingly the claims are held nonstatutory.

23. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 102***

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25. **Claims 28-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chen et al. (US Patent Pub 2003/0005/002) hereinafter “Chen”, using the provisional application filing date.**

26. The Examiner notes that since the provisional application filing date is being used, the specification of the provisional application is cited in the rejections below.

27. In regards to **claim 28**, Chen discloses a method of managing information resources such as web pages in a computer system comprising a user station furnished with a display screen, each resource possessing an identifier (URI) allowing its access from the user station (Fig. 1;

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page 4, lines 16-23; page 5, lines 1-4), method characterized in that it comprises the following steps:

- a. declaration by the user of an association between two resources, by associating with a second resource the identifier of a first resource (Fig. 4A; page 5, lines 16-20; page 6, lines 15-17);
- b. identification of other relevant resources with respect to the second resource (page 6, lines 8-10); and
- c. during access to one of the other resources (current page), signaling of the existence of the first resource (Fig 5)<sup>1</sup>.

28. In regards to **claim 29**, Chen discloses the method as claimed in claim 28, characterized in that step (b) comprises the selection of other resources that are most relevant for the implementation of step (c) (Page 6, lines 8-10)<sup>2</sup>.

29. In regards to **claim 30**, Chen discloses the method as claimed in one of claims 28 and 29, characterized in that step (a) is implemented for a plurality of second resources belonging to a group, and in that step (b) comprises the identification of other relevant resources with respect to the set of second resources of the group (Fig 5; Page 3, lines 16-17; page 5, lines 13-20; page 6, lines 4-10)<sup>3</sup>.

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<sup>1</sup> The figure shows a signal of the first resource in that there are commands (edit and remove) available for each of the second resources and also the commands at the top left of the window.

<sup>2</sup> The relevant web pages that are identified are the most relevant because they are the latest versions of related pages to the second resources that were selected by the user.

<sup>3</sup> As noted on page 3, lines 16-17, a user can associate multiple relevant web pages (a plurality of second resources belonging to a group) and combine them into the composite web page (first resource). Then, as shown in figure 5, multiple second resources can be viewed and the relevant pages are retrieved for each of them (identification of other relevant resources with respect to the set of second resources of the group).

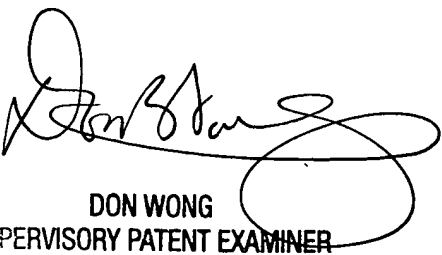
***Conclusion***

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Le  
Art Unit 2163  
October 29, 2006

  
DON WONG  
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